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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,107	06/14/2007	Mario Polegato Moretti	293045US0PCT	6058
22850 7590 10/21/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER VO, HAI				
ART UNIT 1788		PAPER NUMBER		
NOTIFICATION DATE 10/21/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/585,107

Applicant(s)

POLEGATO MORETTI ET AL.

Examiner

Hai Vo

Art Unit

1788

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-51, 56, 61-70, 72 and 75-78 is/are pending in the application.
- 4a) Of the above claim(s) 75 and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-51, 56, 61-70, 72, 77 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Objection to claim 45 has been overcome in view of the present amendment.
2. The submission of a Certified English Translation of Italian Patent Application No. PD2003A000314, filed December 30, 2003 is sufficient to perfect the claim for priority under 35 U.S.C. § 119. The art rejections over Lechhart (US 2005/0172513) are thus withdrawn.
3. The art rejections over JP 2002-336635 have been withdrawn in view of the present amendment. JP'635 fails to teach or suggest the at least one second layer which a plasma deposited ultrathin film of (i) an oil-repellent and water-repellent fluoropolymer or (ii) a polysiloxane.
4. The art rejections over Rechlicz et al. (US 5,032,450) are maintained.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 39-51, 56, 61-70, 72, 77 and 78 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over

Rechlicz et al. (US 5,032,450). Rechlicz teaches a coated article comprising a moisture vapor permeable coating of polysiloxane on one side of the sheet of microporous material (abstract). The microporous material is a matrix of polyolefin and siliceous filler, having interconnecting pores. The polyolefin is formed from a ultrahigh molecular weight polyethylene (UHMWPE) which is commercially available under the trade name Himont 1900. Zachariades et al. (US 5,479,952) will be relied upon to show the state of fact, that is, the UHMWPE has an average molecular weight from 3 to 4 million g/mole. This is within the claimed range. The siliceous filler has an average particle size and average surface area within the claimed ranges (column 7, lines 1-5; and column 9, lines 58-60). The microporous material has a thickness of 30 to 400 microns, an average pore size of 0.02 to 0.5 microns and a porosity in the range from 60 to 70% (column 3, lines 35-40; column 10, lines 20-22; and 30-35). It appears that the microporous material meets all the structural limitations and chemistry set forth in the claim. Therefore, it is the examiner's position that the hygroscopic property would be inherently present as like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. The coated article is structurally the same as the multilayer article of the present invention regardless of whether the microporous membrane is commercially available on the market. The polysiloxane solution is applied on the microporous material by spreading (column 14, lines 10-20). Rechlicz does not specifically

disclose that the polysiloxane coating is obtained by way of a plasma deposition treatment. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Rechlicz is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The coated article comprises a moisture vapor permeable coating of polysiloxane on one side of the sheet of microporous material (abstract). The microporous material is a matrix of polyolefin and siliceous filler, having interconnecting pores. The polyolefin is formed from a Ultrahigh molecular weight polyethylene (UHMWPE) which is commercially available under the trade name Himont 1900. Zachariades et al. (US 5,479,952) will be relied upon to show the state of fact, that is, the UHMWPE has an average molecular weight from 1 to 8 million g/mole. This is within the claimed range. The siliceous filler has an average particle size and average surface area within the claimed ranges (column 7, lines 1-5; and column 9, lines 58-60). The microporous material has a thickness of 30 to 400 microns, an average pore size of 0.02 to 0.5 microns and a porosity in the range from 60 to 70% (column 3, lines 35-40; column 10, lines 20-22; and 30-35). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Rechlicz. Accordingly, Rechlicz anticipates or strongly suggests the claimed subject matter.

8. The art rejections over Rechlicz have been maintained for the following reasons. Applicants contend that the coated article of the prior art is structurally different from the presently claimed multilayer article because Rechlicz fails to teach a plasma deposited ultrathin film of a polysiloxane set out in the claim. Applicants then go on that the polysiloxane of the present invention made from the plasma deposition has a thickness less than 200 microns. However, nothing in the claim is specific about the thickness of the polysiloxane. Even if the claim is amended by adding the limitation of the polysiloxane thickness of less than 200 microns, the amendment does not render the claim unobvious over the prior art. Rechlicz discloses the coated article comprising a microporous substrate and a polysiloxane coating on the surface of the microporous substrate. This at least indicates that the polysiloxane coating is thinner than the microporous substrate.

The fact that the microporous substrate has a thickness of 134 microns (table V) implies that the polysiloxane coating would have a thickness less than 134 microns. This is within the claimed range. Applicants also mention that the porosity, surface morphology, permeability, purity, and adhesion bonding strength of the plasma deposited film are not identical to those of the film formed from conventional coating methods. However, none of these special features which are resulted from the plasma deposition treatment have been incorporated into the claim to show the unobvious difference between the claimed product and the prior art product. Accordingly, the art rejections are maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/
Primary Examiner, Art Unit 1788